

PATENT**Application # 10/733,719****Attorney Docket # 2002-0465 (1014-048)****REMARKS**

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 5, 6, 15, and 20 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 15, and 20 are in independent form.

The Obviousness Rejections

Each of claims 1-20 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of Matsushita (U.S. Publication No. 2004/0056768), Davis (U.S. Patent No. 6,609,690), Amer (U.S. Patent No. 5,790,025), and/or Dodley (U.S. Patent No. 5,966,229). These rejections are respectfully traversed.

PATENT**Application # 10/733,719****Attorney Docket # 2002-0465 (1014-048)****A. Inherency**

Inherency “requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

The present Office Action recites that “[r]egarding claim 12: Matsushita et al. inherently teach increasing the emitted power of the FSOC system (paragraph 0047).” *See*, Page 3. No evidence has been presented that the admittedly “missing descriptive material is ‘necessarily present’” in Matsushita. Applicants respectfully request provision of evidence supporting the assertion that “Matsushita et al. inherently teach increasing the emitted power of the FSOC system.”

B. *Prima Facie* Criteria

None of the applied portions of the relied upon references, either alone or in combination, establish a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” *See* MPEP 2143. Moreover, the USPTO “has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

PATENT

Application # 10/733,719

Attorney Docket # 2002-0465 (1014-048)

C. Missing Claim Limitations**a. Claims 1, 15, and 20**

Independent claim 1 recites, yet none of the applied portions of the relied upon references expressly or inherently teach or suggest, “reducing an emitted power of the FSOC system to a **non-zero level**”.

Independent claim 15 recites, yet none of the applied portions of the relied upon references expressly or inherently teach or suggest, “a switch adapted to reduce an emitted power of the FSOC subsystem to a **non-zero level**.”

Independent claim 20 recites, yet none of the applied portions of the relied upon references expressly or inherently teach or suggest, “means for reducing an emitted power of the FSOC subsystem in response to sensing the intruder to a **non-zero level**.”

Instead, Matsushita allegedly recites the “electric shock preventing means is preferably means for bringing the solar cell module or a solar cell string consisting of solar cell modules connected in series, into a short-circuit state. This enables the system to be **shut down immediately** without breaking the photovoltaic power generation system **and further renders the voltage null at each part of the series solar cell modules**, whereby the intruder can be prevented from experiencing a hazard such as an electric shock or the like.” See paragraph 0047. None of the applied portions of the remaining relied upon references overcome the deficiencies of Matsushita.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the cited references (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modify the applied portions of the cited references (another assumption that is respectfully traversed), the applied portions of the cited references still do not expressly or inherently teach or suggest **every** limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

PATENT**Application # 10/733,719**

Attorney Docket # 2002-0465 (1014-048)

Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

D. No Motivation or Suggestion to Combine Applied References

“When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to **suggest the desirability**, and thus the obviousness, of making the combination.” *Akamai Techs. v. Cable & Wireless Internet Servs.*, 344 F.3d 1186, 68 USPQ 2d 1186 (Fed. Cir. 2003) (emphasis added).

According to the Federal Circuit the “mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)). In that same case, the Federal Circuit further held that it “is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” *Id.*, 23 USPQ 2d at 1784.

The present Office Action presents no evidence whatsoever that any of the applied references provide a suggestion or motivation for a combination with any of the other applied references. Instead, regarding the proffered combinations, the present Office Action recites:

1. “it would have been obvious to the skilled artisan to utilize the technique of Davis in the system of Matsushita et al. to detect an intruder within a predetermined vicinity of a Free Space Optical Communication **if desired**. See Page 2.
2. [r]egarding claim 4: Matsushita et al. teach calculating a comparison calculated value D (paragraph 0028) but do not teach comparing a sensed voltage to a

PATENT**Application # 10/733,719****Attorney Docket # 2002-0465 (1014-048)**

reference voltage. However, it would be an obvious to a skilled artisan to have the sensed voltage that can be compared to a reference voltage if desired." *See*, Page 3;

3. "it would have been obvious to the skilled artisan to employ the technique of Amer et al. as an alternative way of determining the nature and/or direction of the intruder's movements." *See* Page 4; and
4. "it would have been obvious to the skilled artisan to employ the teaching of Dodley et al. in the system of the combination so that the emitted power is not harmful to the intruder which is an advantage." *See* Page 5.

Thus, the present Office Action fails to provide any evidence that the prior art provides any suggestion or motivation to combine the applied references. Instead, the present Office Action appears to use only legally impermissible hindsight in asserting that the modification allegedly would have been obvious. Accordingly, the combination of Matsushita with Davis, Amer, and/or Dodley is impermissible.

Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of the rejections based upon these applied references is respectfully requested.

E. Matsushita Teaches Away a Combination to Arrive At Claimed Subject Matter

Federal Circuit law indicates that references "that teach away cannot serve to create a *prima facie* case of obviousness." *See*, In re Gurley, 27 F.3d 551, 553, 31 U.S.P.Q.2D (BNA) 1130, 1132 (Fed. Cir. 1994). If a proposed combination would render a reference inoperable for its intended purpose, the reference teaches away from the proposed combination. *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1994). "If references taken in combination would produce a 'seemingly inoperative device,' ... such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness". *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001).

PATENT**Application # 10/733,719**

Attorney Docket # 2002-0465 (1014-048)

Independent claim 1 recites, yet none of the applied portions of the relied upon references expressly or inherently teach or suggest, “reducing an emitted power of the FSOC system to a **non-zero level**”.

Independent claim 15 recites, yet none of the applied portions of the relied upon references expressly or inherently teach or suggest, “a switch adapted to reduce an emitted power of the FSOC subsystem to a **non-zero level**.”

Independent claim 20 recites, yet none of the applied portions of the relied upon references expressly or inherently teach or suggest, “means for reducing an emitted power of the FSOC subsystem in response to sensing the intruder to a **non-zero level**.”

Instead, Matsushita allegedly recites the “electric shock preventing means ... enables the system to be **shut down immediately** without breaking the photovoltaic power generation system and further **renders the voltage null at each part of the series solar cell modules....**”

See paragraph 0047. Thus, Matsushita actually teaches away from “the level allowing a communications link involving the FSOC system to remain operative.”

Nothing in Matsushita would suggest to a person of ordinary skill in the art that Matsushita should be combined with any of the applied portions of the relied upon references to arrive at the claimed subject matter. Indeed, Matsushita **teaches away** from any such modification because Matsushita’s “system” is “shut down immediately” and the voltage is “null at each part of the series solar modules.”

Accordingly, it is inappropriate to use Matsushita in a rejection of the claimed subject matter of claims 1-20. Consequently, Applicant respectfully requests withdrawal of each rejection of claims 1-20.

PATENT

Application # 10/733,719

Attorney Docket # 2002-0465 (1014-048)

Allowable Subject Matter

A potential statement of reasons for the indication of allowable subject matter is:

“none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely,

claims 1-14 are allowable because none of the applied portions of the relied upon references of record alone or in combination disclose or suggest ‘reducing an emitted power of the FSOC system to a non-zero level’;

claims 15-19 are allowable because none of the applied portions of the relied upon references of record alone or in combination disclose or suggest ‘a switch adapted to reduce an emitted power of the FSOC subsystem to a non-zero level; and

claim 20 is allowable because none of the applied portions of the relied upon references of record alone or in combination disclose or suggest ‘means for reducing an emitted power of the FSOC subsystem in response to sensing the intruder to a non-zero level.’”

PATENT

Application # 10/733,719

Attorney Docket # 2002-0465 (1014-048)

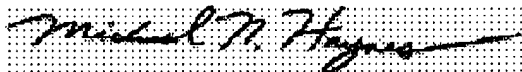
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



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Michael N. Haynes
Registration No. 40,014

1341 Huntersfield Close
Keswick, VA 22947
Telephone: 434-972-9988
Facsimile: 815-550-8850